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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/810,625

Applicant(s)

TORNABENE ET AL.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 28, 35, 40-58 and 60-64 is/are pending in the application.
- 4a) Of the above claim(s) 61-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 28, 35, 40-58 and 60-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to the Amendment for Application Number 09/810,625 received on 10/30/2007.
2. Claims 1-23, 35-38, and 40-58, 60-64 are presented for examination.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23, 35-38, 40-58, 60-61, drawn to a host system maintaining a contacts list and updating the list when members are invited and join the group, classified in class 709, subclass 204.
 - II. Claims 62-64, drawn to detecting a change in a group of instant messaging participants and updating the display of a participant to reflect the change, classified in class 709, subclass 224.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as maintaining a group list at a host system and performing updates to the list as users are invited/added. Subcombination II has separate utility such as monitoring for changes in

an instant messaging group and detecting changes in membership of the group and causing a display to reflect those changes. See MPEP § 806.05(d).

These inventions are distinct for the reasons given above, and the search required for each Group is different, as shown the above Class/subclass classifications, and not co-extensive for examination purpose.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 62-64 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 35-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claim 35 recites, "A computer program, stored on a tangible computer readable medium."

Applicant's specification states:

"The computer readable medium may comprise a disc, a client device, a host device, and/or a propagated signal" [See Applicant's Specification, page 3, lines 25-

26]. Applicant's specification also makes reference to a propagated signal on p 5, line 10; p 6, line 15; p 20, line 5.

See, e.g., *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. op. at 18)(“A transitory, propagating signal like Nuijten's is not a ‘process, machine, manufacture, or composition of matter.’ ... Thus, such a signal cannot be patentable subject matter.”).

Therefore, Applicant has provided intrinsic evidence in the specification that the phrase “computer-readable medium” as used in the claims is intended to cover signals. Applicant's inclusion of a propagated signal would have been reasonably interpreted by one of ordinary skill as a form of energy rather than a process, machine, manufacture or composition of matter.

Therefore, claims 35-38 contain subject matter that does not fall within one of the four statutory categories of invention. As such, claims 35-38 are not limited to statutory subject matter and are therefore non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2154

6. Claims 1, 2, 8, 15-16, 18-20, 22-23, 35, 36, 38, 58, and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Harvey et al. (U.S. 6,487,583)

7. Regarding claims 1 and 35, Harvey disclosed a computer implemented method of sharing static data resources associated with a group among members of the group, the method comprising:

storing, on a host system and for a group, a single copy of a member-only collection of contact information that is associated with and accessible to members of the group, the collection of contact information including contact information for each member of the group (Harvey, col. 12, lines 38-50, Harvey disclosed that a creator may determine how users can interact within the community. Each user may be required by the creator to create a profile and require them to include their name and address in the profile. Harvey explicitly disclosed this profile being accessed by other users of the community);

limiting access to the single copy of the collection of contact information to members of the group (col. 12, lines 38-50, Harvey disclosed that a creator may determine how users can interact within the community; col. 11, lines 26-50, Harvey disclosed the creator may specify the level of access and may indicate what users may access the community, Therefore it is clear that if the creator only specifies members of the community to access the community, only the members have access to the community members' profiles);

enabling access to the single copy of the collection of contact information stored on the host system by a group member only when the member successfully logs into the host system and initiates access to the stored single copy of the collection of contact information (Harvey, col. 5, lines 1-5, each user uses a user ID and password at login in order to access the community; col. 5, lines 9-15, Once the user enters the community, the user can access the content objects of the community);

storing information associated with more than one current member of the group in a database (Harvey, col. 5, lines 1-5, The system must store at least the usernames and passwords in order to authenticate users when logging in; col. 6, lines 54-67, "email database module" "various communities, clients, subscription objects, executable components and other items may be stored in data storage module");

receiving instructions from at least one current member to invite at least one prospective member to join the group (Harvey, col. 4, lines 49-52);

sending an invitation to the prospective member to join the group (Harvey, col. 4, lines 51-55, "The creator selects the names and e-mail addresses of the individuals to be invited to access the community");

receiving a response from the prospective member (Harvey, col. 4, line 61 through col. 5, line 5; Harvey disclosed the user accepting the invitation and registering with the central controller);

adding the prospective member to the group as a new member based upon receipt of an affirmative response (Harvey, col. 14, lines 45-50, Harvey disclosed an executable helping the user in registering to the community; col. 14, lines 62-67, Harvey

disclosed the executable may assist an invited user in accepting and registering for a community obtaining the proper information);

automatically updating group membership to account for the new member (Harvey, col. 15, lines 1-8, When the executable is launched, it reads info from the user and connects to the server to begin setup and download of a client application for a community, thereby completing registration; The user being registered with the group means the group is updated to include the user);

storing information associated with the new member in the database (Harvey, col. 15, lines 5-9, Harvey disclose storing user-specific information);

updating the single copy of the collection of contact information stored on the host system to include contact information for the new member (Harvey, col. 12, lines 38-50, Each user may be required by the creator to create a profile and require them to include their name and address in the profile. Harvey explicitly disclosed this profile being accessed by other users of the community)

enabling access to the single copy of the updated collection of contact information stored on the host system by the current members of the group and the new member based upon the updated group membership (Harvey, col. 15, lines 3-5, Harvey disclosed the new member gets set up and downloads the application to be part of the community; col. 5, lines 9-15, using the user interface, the user can interact with the community and access the content objects, as explained above, the members' profiles are accessible by the other members of the group); and

enabling access to the stored information associated with the current members of the group and the new member based upon the updated group membership (Harvey, col. 15, lines 3-5, Harvey disclosed the new member gets set up and downloads the application to be part of the community; back to col. 5, lines 9-15, using the user interface, the user can interact with the community and access the content objects including user profiles).

Claim 35 includes a computer program with limitations that are substantially similar to the limitations of claim 1. Harvey clearly disclosed providing a program (see Abstract; col. 4, lines 45-60; col. 5, lines 9-15) in order to implement these steps. Therefore, claim 35 is rejected under the same rationale.

8. Regarding claim 2, Harvey disclosed the limitations as described in claim 1, including wherein sending the invitation comprises using an e-mail message (Harvey, col. 4, lines 50-53).

9. Regarding claim 8, Harvey disclosed the limitations as described in claim 1, including wherein automatically updating group membership to account for the new member comprises providing a list of current members that includes the new member (Harvey, col. 17, lines 25-35 "Pals List"; By default a user invited into a community is added to the Pals List).

10. Regarding claim 15, Harvey disclosed the limitations as described in claim 1, including wherein sharing the stored information associated with the current members of the group and the new member comprises enabling current members of the group to send instant messages to other current members of the group including the new member (Harvey, col. 18, lines 25-39, "Instant Message" feature between members of the group).

11. Regarding claim 16, Harvey disclosed the limitations as described in claim 1, including wherein sharing the member-only static data resources associated with the current members of the group and the new member comprises sharing data files with current members of the group including the new member (Harvey, col. 4, lines 35-36, the members of the community can view photos from the photo album application).

12. Regarding claims 18-20, Harvey disclosed the limitations as described in claim 16, including wherein the data files comprise digital images or photographs (Harvey, col. 4, lines 34-36, "photographs" viewed on a computer are digital images) or text files (Harvey, col. 4, lines 38-43, "information about upcoming events" clearly includes text about such events; col. 7, lines 36-40 "text for announcements screen").

13. Regarding claim 22, Harvey disclosed the limitations as described in claim 1, including offering new services based upon the current members of the group including

the new member (Harvey, col. 5, lines 10-20; Members may access application objects and content objects which are automatically updated).

14. Regarding claim 23, Harvey disclosed the limitations as described in claim 1, including wherein sharing the member-only static data resources associated with the group with the current members of the group and the new member comprises providing information in an instant messaging buddy list that includes information for the new member (Harvey, col. 18, lines 30-35, "Pal list" for instant messaging).

15. Regarding claim 36, Harvey disclosed the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a disc (Harvey, col. 23, lines 52-54, "CD-ROM").

16. Regarding claim 38, Harvey disclosed the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a host device (Harvey, Fig. 1, 115 is clearly a host device on a network; col. 22, lines 35-36, The central controller may operate as a server).

17. Regarding claim 58, Harvey disclosed the limitations as described in claim 1, including wherein sharing the member-only static data resources associated with the group with the current members of the group and the new member comprises sharing

buddy list information (Harvey, col. 18, lines 25-35, Harvey disclosed the members share a "Pal list" in order to communicate with the members of the community).

18. Regarding claim 61, Harvey disclosed the limitations as described in claim 1 Enabling access to a member-only collection of links to favorite web sites by members of the group, the collection of links to favorite web sites including links to favorite web sites that have been contributed by members of the group; and limiting access to the member-only collection of links to favorite web sites to members of the group (Harvey, col. 7, lines 9-14, 35-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-2, 8, 16-17, 35-36, 38, 42, 44-50, 54, 55 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (U.S. 7,136,903) in view of Lindquist (US 6,931,419).

20. Regarding claims 1 and 35, Phillips disclosed a computer implemented method of sharing static data resources associated with a group among members of the group (Phillips, col. 6, lines 2-5, "multi-user file storage service and system" and "user group"), the method comprising:

storing a single copy of member-only static data resources associated with and accessible to a group in a host system (Phillips, col. 6, lines 14-20, integrity of the files at the remote file server are maintained; col. 9, lines 23-25 "a master copy of each file of the group is persistently maintained");

sharing the single copy of data resources with a group member only when the member successfully logs into the host system and initiates access to the stored single copy of data resources (Phillips, col. 7, lines 9-13, "The remote file server node only permits the access to the particular file by the specific client node if permitted by the privilege access rights associated with the particular file"; Fig. 7, S200 USERID, col. 19, lines 24-26, Phillips disclosed the user supplies a password; lines 45-55, Phillips disclosed the user being authenticated by the remote file server, thereby the user only able to access the files after a successful login);

storing information associated with more than one current member of the group in a database (Phillips, Fig. 3, Remote file server 61 containing local disk store; col. 19, lines 60-65, Phillips disclosed the remote file server storing a list of valid, pre-subscribed usernames);

receiving instructions from at least one current member to invite at least one

prospective member to join the group (Phillips, col. 6, lines 45-50, Phillips disclosed a client manager able to invite new members; col. 12, lines 50-52, Phillips disclosed the file server software accepts requests from client manager nodes to create new client user accounts);

sending an invitation to the prospective member to join the group (Phillips, col. 6, lines 46-48, Phillips disclosed sending an invitation via email to the prospective member);

receiving a response from the prospective member (Phillips, col. 6, lines 48-50, "Using the information in the message, a client node operated by the user issues a message to join the user group", Clearly the server would have to receive this message in order to successfully join the member to the group);

adding the prospective member to of the group as a new member based upon receipt of an affirmative response (Phillips, col. 6, lines 49-50, The user joins the group, meaning the user is added as a new member based on the user's response to the message);

automatically updating group membership to account for the new member (Phillips, col. 6, lines 49-51, the user joins the group which requires updating group membership; col. 12, lines 50-56; "enabling client users to join pre-subscribed user groups");

storing information associated with the new member in the database (Phillips, col. 12, lines 51-56, creation of user accounts as well as deletion of user accounts requires the file server to store the user accounts, Fig. 3, file server 61 shows a

database clearly used for storing such data; col. 19, lines 60-65, Phillips disclosed the remote file server storing a list of valid, pre-subscribed usernames);

sharing the member-only static data resources associated with the group among the current members of the group and the new member based upon the updated group membership (Phillips, col. 12, lines 56-60, "Arbitrating accesses to file data amongst all client nodes, including enforcing access privileges and file sharing modes" In other words, only pre-subscribed users of the group have access to the virtual storage that is assigned to the group; col. 12, lines 39-41 further explains this functionality); and

sharing the stored information associated with the current members of the group and the new member based upon the updated group membership (Phillips, col. 12, lines 39-41, "the client manager node is able to designate new user accounts and to provide sufficient information to enable a client user to join one or more of the virtual storage devices managed by the client manager node" meaning the data within the virtual storage device is shared only by the users of the group).

Phillips also disclosed the fact that users in a group are enabled to access the data in a shared fashion (col. 9, lines 25-30).

While Phillips disclosed groups being created and sharing data among members of a group, Phillips did not explicitly state the sharing of contact information between the members of the group. Phillips did not explicitly state the host system storing a collection of contact information for each member of the group and providing access to this contact information only upon successful login, as well as updating the contact

information to include contact information for the member and enabling access to this new updated information by the members of the group.

In an analogous art of sharing data amongst members of a group, Lindquist disclosed a data management system for maintaining and propagating user data among communities in which an address book is continuously populated and updated, the address book resident on the community membership data management system (col. 4, lines 4-13, 58-64). Lindquist further disclosed the community membership data management system storing attributes for each member such as mailing address and other contact information such as email address. Lindquist disclosed that this member data is distributed to other communities in an organized manner to protect this data from disclosure to individuals who do not have a right to access this data as well as to limit the data elements that are provided to each community. Lindquist provides the example using a community of family members having access to member data that differs from the member data that is shared with the community of business associates (Lindquist, col. 5, lines 44-60). Therefore it can be seen from these citations that Lindquist disclosed members of a community having permitted access to contact information (such as a shared address book) of other members of their own community, and also are provided with an updated address book as it is continuously updated.

Both Phillips and Lindquist are analogous art as both provide host systems that share data among members of a specified group. While Phillips disclosed the sharing of files and data, Lindquist further disclosed such data to include contact information. As such, Lindquist provides a more specific type of data that is shared. One of ordinary

skill in the art would have been motivated to combine the teachings of Phillips and Lindquist since they are within a related environment of sharing data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Lindquist into the system of Phillips to provide the predictable result of allowing users of Phillips to share contact information, as well as to allows users who are operating in a shared fashion (as disclosed by Phillips, c. 9, lines 25-30) to be able to communicate with each other and discuss data that they share a common interest for in order to provide users with a more community-based system, thereby increasing desirability of customers to utilize the system.

Claim 35 includes a computer program with limitations that are substantially similar to the limitations of claim 1. Phillips clearly disclosed providing a program (Phillips, col. 12, lines 42-45) in order to implement these steps. Therefore, claim 35 is rejected under the same rationale.

21. Regarding claim 2, Phillips and Lindquist disclosed the limitations as described in claim 1, including wherein sending the invitation comprises using an e-mail message (Phillips, col. 6, lines 49-50).

22. Regarding claim 8, Phillips and Lindquist disclosed the limitations as described in claim 1, including wherein automatically updating group membership to account for the new member comprises providing a list of current members that includes the new

member (Phillips, col. 19, lines 65-67, Phillips disclosed the remote file server using a list of the pre-subscribed users, which clearly would include the new member).

23. Regarding claim 16, Phillips and Lindquist disclosed the limitations as described in claim 1, including wherein sharing the member-only static data resources associated with the current members of the group and the new member comprises sharing data files with current members of the group including the new member (Phillips, col. 6, lines 8-13, Phillips disclosed that each member of the group has access to group data files. Since the new member is part of the group, the new member would also have access to the group data files).

24. Regarding claim 17, Phillips and Lindquist disclosed the limitations as described in claim 16, including wherein the data files are provided by the current members of the group (Phillips, col. 6, lines 40-44, Phillips disclosed client nodes uploading files for storage at the remote file server node).

25. Regarding claim 36, Phillips and Lindquist disclosed the limitations as described in claim 35, including wherein the computer readable medium is a disc (Phillips, col. 8, lines 25-33, fixed or removable disk).

26. Regarding claim 38, Phillips and Lindquist disclosed the limitations as described in claim 35, including wherein the computer readable medium is a host device (Phillips, col. 6, lines 36-37, "remote file server node").

27. Regarding claim 42, Phillips and Lindquist disclosed the limitations as described in claim 1, including in which storing information about all members of a group comprises storing information about all members of a private group (Phillips, col. 19, lines 60-67, The remote server stores usernames of the group).

28. Regarding claim 44, Phillips and Lindquist disclosed the limitations as described in claim 1, including wherein the invitation comprises a personalized message to the prospective member (Phillips, col. 6, lines 45-50, The invitation includes an email message).

29. Regarding claim 45, Phillips and Lindquist disclosed the limitations as described in claim 1, including authorizing an invitation to be sent to the prospective member (Phillips, col. 6, lines 45-50, The client manager creates the group and selects users to send the invitations).

30. Regarding claim 46, Phillips and Lindquist disclosed the limitations as described in claim 45, including wherein the authorizing is performed by a group founder (Phillips, col. 6, lines 45-50, The client manager creates and controls the group, thereby being the group founder).

31. Regarding claim 47, Phillips and Lindquist disclosed the limitations as described in claim 45, including wherein the authorizing is performed by a group owner (Phillips, col. 6, lines 45-50, The client manager creates and controls the group, thereby being the group owner).

32. Regarding claim 48, Phillips and Lindquist disclosed the limitations as described in claim 1, including deleting a current member (Phillips, col. 12, lines 55-56; client manager can delete user accounts).

33. Regarding claim 49, Phillips and Lindquist disclosed the limitations as described in claim 48, including wherein the deleting is performed by a group founder (Phillips, col. 6, lines 45-50, The client manager creates the group and handles the deletions).

34. Regarding claim 50, Phillips and Lindquist disclosed the limitations as described in claim 48, including wherein the deleting is performed by a group owner (Phillips, col. 6, lines 45-50, The client manager creates the group and handles the deletions).

35. Regarding claim 54, Phillips and Lindquist disclosed the limitations as described in claim 1, including providing a notification of the response to one or more current members (Phillips, col. 6, lines 45-51, col. 19, lines 60-67; Phillips disclosed the manager issuing an email invitation to a prospective member, and the user issuing a

message in order to join, and when the user successfully joins, the list of pre-subscribed users is updated, which provides notification to the client manager that the user has been added; As noted earlier, the client manager has the rights to who is added or removed from the group; which would clearly require the manager to be notified of who is currently in the group).

36. Regarding claim 55, Phillips and Lindquist disclosed the limitations as described in claim 1, including treating the new member as a current member (Phillips, col. 19, lines 60-67, Phillips disclosed the new user becomes part of the list of pre-subscribed users, and is thereby clearly treated as a current member).

37. Regarding claim 60, Phillips and Lindquist disclosed the limitations as described in claim 1, including wherein sharing the single copy of data resources with a group member only when the member successfully logs into the host system and initiates access to the stored single copy of data resource comprises enabling multiple members to concurrently access the single copy of data resources (Phillips, col. 9, lines 4-6, "simultaneous client node access to groups of files").

38. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips and Lindquist and further in view of Shah (U.S. 2001/0013050).

39. Regarding claims 3 and 4, Phillips and Lindquist disclosed the limitations as described in claim 1. Phillips disclosed the client manager communicating to a prospective member an invitation to join the group of users permitted to access the virtual storage device (Phillips, col. 16, lines 55-60). Phillips disclosed, as an example, that the client manager can use email to send the invitation (Phillips, col. 16, lines 60-63).

Phillips and Lindquist did not explicitly state using an instant message or on-line chat to send the invitation.

40. However, by the cited disclosure regarding the use of email, Phillips clearly indicates that such use of email is an example of the communication that can be used (Phillips, col. 16, lines 60-63), and it would have been obvious to one of ordinary skill in the art that other forms of communication could be used to transmit the invite message.

Since the mere use of message is simply to provide the invite information to the user, it would have been obvious for a network administrator to use any standard form of communication in order to provide this information. Instant messaging and on-line chat, like e-mail, are standard forms of communication that were well known at the time the invention was made. Using instant messaging or on-line chat would result in the same outcome, which is, providing the invitation information to the user.

In an analogous art, Shah disclosed a system which allows members to invite users to join a group (Shah, [0075]) using email, instant messaging, or chat services (Shah, [0124]).

Therefore it would have been obvious for one of ordinary skill in the art to incorporate the multiple forms of communication of Shah into the teachings of Phillips and Lindquist in order to allow members to use instant messaging or on-line chat as a form of communication when sending invitations, in order to provide users with a scalable system that can be implemented across well known standards of communication, thereby allowing users, having different preferred types of communication, to send invitations using the type communication that best fits their needs.

It would have also been obvious to one of ordinary skill in the art to use forms of communication including instant messaging and online chat in order to obtain the predictable result of transmitting the invitation to the prospective user.

41. Regarding claims 5-7, Phillips and Lindquist disclosed the limitations as described in claim 1.

Phillips disclosed that the "activation of the join process results in the transmission of a message from the client node to the appropriate remote file server node (Phillips, col. 17, lines 25-30). However, Phillips and Lindquist did not limit this message to a specific type of communication.

Since Phillips did not limit the response message to any specific message, this would have motivated a network administrator to look for any standard types of communication to implement with the system. Email, instant messaging, and online chat are all well known standard forms of communication that allow information to be

passed between devices. Using such forms would result in the same outcome, which is, responding to the invite.

In an analogous art, Shah disclosed a system which allows users to communicate using email, instant messaging, or chat services (Shah, [0124]). Show shows that such forms may be used to invite users (Shah, [0124]) and therefore it would have been obvious to one of ordinary skill that such forms may be used for responding.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the types of communication of Shah into the teachings of Phillips and Lindquist in order to allow users send response messages using standard protocols including instant messaging, email, and on-line chat to provide users with a system that can be implemented across publicly used standards of communication, thereby allowing users, having different preferred types of communication, to reply to invitations using the type communication that best fits their needs.

It would have also been obvious to one of ordinary skill in the art to use forms of communication including instant messaging and online chat in order to obtain the predictable result of responding to the invitation by the prospective user.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips and Lindquist and further in view of Waesterlid (U.S. 6,993,325).

Regarding claim 9, Phillips and Lindquist disclosed the limitations as described in claim 1.

Phillips did not explicitly state wherein automatically updating group membership to account for the new member comprises providing information in an address book that includes address information for the new member.

In an analogous art, Waesterlid disclosed a system that allows users to invite other users to join an affinity group and if the prospective member accepts the invitation, the server adds the prospective member to a member database in which information such as address information for the new member is provided (Waesterlid, col. 7, line 63 through col. 8, line 45-55).

Both Phillips and Waesterlid disclosed similar systems in which users are invited to join a group, giving them the ability to share data.

Therefore it would have been obvious for one of ordinary skill in the art to incorporate providing address information for each member of the group into the teachings of Phillips and Lindquist to obtain the predictable results of providing such data to the members that request it, in order for the group members to obtain more detailed contact information about each other, giving them options as to the ways of communicating between members.

42. Regarding claim 10, Phillips Lindquist and Waesterlid disclosed the limitations as described in claim 9, including updating the address book based upon information entered by the current members of the group (Waesterlid, col. 8, lines 54-60, Waesterlid

disclosed the client application taking appropriate action to add, delete, or modify member records in the corresponding group database, wherein modifying member records from the update message is based from the data being entered by those members). See motivation above.

43. Claims 11-13, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips and Lindquist and further in view of Nickerson (U.S. 6,396,512).

44. Regarding claim 11, Phillips and Lindquist disclosed the limitations as described in claim 1.

While Phillips disclosed a "multi-user file storage service and system" that allows the users to share a data store (Phillips, Fig. 3, data stores for remote servers 61 and 62), Phillips did not explicitly state wherein sharing the member-only static data resources associated with the group with the current members of the group and the new member comprises providing information in a shared group calendar that includes information for the new member.

In an analogous art, Nickerson disclosed a method for sharing calendar information between a plurality of users (Nickerson, col. 5, lines 41-45) in which a server includes a database section storing event data from the plurality of users (Nickerson, col. 7, lines 13-20). Nickerson allows users to share their calendar event data with specific users (Nickerson, col. 9, lines 1-7) that are within their "CIRCLE OF INTEREST"

(Nickerson, col. 9, lines 7-9), in which the server authenticates each user at login before the user has access to the database (Nickerson, col. 11, lines 48-53). Therefore, each user sharing their individual calendar events within the Circle of Interest results in a shared group calendar, made up of events from the Circle of Interest. From the disclosure of Nickerson, it is clear that any user within the Circle of Interest is able to share their calendar event data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that any new users within the Circle of Interest would also be able to share their event data.

As shown above, Phillips and Lindquist disclosed a "multi-user file storage service and system" that allows the users to share a data store (Phillips, Fig. 3, data stores for remote servers 61 and 62), which is very similar to the "shared drive" technique.

Nickerson provides an example of the "shared drive" arrangement in which a set of users are given access to a particular drawer by a system administrator, giving each user access to each file in the drive (Nickerson, col. 3, lines 63-67). Nickerson disclosed that such "shared drawer" arrangements are well known in the use of maintaining calendars between personal computers (Nickerson, col. 3, lines 55-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the shared calendar events of Nickerson into the secured group "shared drive" arrangement of Phillips to provide a flexible security system for a calendar scheme in which access rights could be set in a customized fashion for each piece of information downloaded to the "shared drive,"

(Nickerson, col. 4, line 66 through col. 5, line 2) for the benefit of allowing users to share specific calendar events only with the group members for which the specific calendar events were intended (Nickerson, col. 5, lines 24-26).

45. Regarding claim 12, Phillips Lindquist and Nickerson disclosed the limitations as described in claim 11, including updating the shared group calendar based upon information entered by the current members of the group (Nickerson, col. 8, line 60 through col. 9, line 6, Nickerson disclosed a user providing a calendar event and able to share it with the Circle of Interest). See motivation above.

46. Regarding claim 13, Phillips Lindquist and Nickerson disclosed the limitations as described in claim 11, including inviting current group members to attend an event and automatically recording the event in the shared group calendar (Nickerson, col. 8, line 60 through col. 9, line 6, Nickerson disclosed a user providing a calendar event and able to share it with the Circle of Interest; Once the user completes the event and submits it, the event is stored in the server's database). See motivation above.

47. Regarding claim 40, Phillips and Lindquist disclosed the limitations as described in claim 1, including wherein a client manager node chooses which users may join their group (Phillips, col. 6, lines 45-46).

Phillips and Lindquist did not explicitly state wherein the current members of the group comprise members of a family. Phillips and Lindquist did not restrict the group members to any specific type group.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made the client manager is able to make a group strictly for family members, in order to obtain the predictable outcome of choosing which users may join the group.

In an analogous art, Nickerson disclosed sharing event related information only with members of a Circle of Interest (Nickerson, col. 9, lines 7-10) in which the members may be members of a family (Nickerson, col. 9, lines 40-45, "SON" "DAUGHTER"). See motivation above.

48. Regarding claim 41, Phillips and Lindquist disclosed the limitations as described in claim 1. Phillips and Lindquist did not explicitly state wherein the prospective member comprises a relative of a current member of the group.

In an analogous art, Nickerson disclosed sharing event related information only with members of a Circle of Interest (Nickerson, col. 9, lines 7-10) in which the members may be members of a family (Nickerson, col. 9, lines 40-45, "SON" "DAUGHTER").

See motivation above.

49. Claim 14, 22, 43 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips and Lindquist and further in view of Kenyon (U.S. 6,701,343).

50. Regarding claim 14, Phillips and Lindquist disclosed the limitations as described in claim 1.

Phillips and Lindquist did not explicitly state wherein sharing the member-only static data resources associated with the group with the current members of the group and the new member comprises providing an on-line forum for current members of the group to chat with other current members of the group including the new member.

In an analogous art, Kenyon disclosed a system and method for automated website creation and access in which a system user may create a community website that provides community members with a forum to communicate between the members (Kenyon, col. 2, lines 41-46, 51-60). Kenyon further disclosed that the system user may configure the website with security features in order to limit access to particular users (Kenyon, col. 2, line 63 through col. 3, line 5).

Phillips Lindquist and Kenyon disclosed systems allowing authorized users access to specific group member area storage space (Phillips, col. 7, lines 9-13; Kenyon, col. 3, lines 7-13). Kenyon further provides users with a way of communicating between members to allow them to discuss and share group topics and interests (Kenyon, col. 4, lines 9-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the communication features of Kenyon into the shared group storage access of Phillips and Lindquist in order to enable users who share a common interest (such as photos, media) to not only be able to share data on a

shared drive, but also to be able to communicate with each other to discuss such common interests.

51. Regarding claim 22, Phillips and Lindquist disclosed the limitations as described in claim 1. Phillips and Lindquist did not explicitly state including offering new services based upon the current members of the group including the new member.

In an analogous art, Kenyon disclosed community websites in which any member of the community is allowed to contribute and update the website to provide its members with new services (Kenyon, col. 4, lines 25-35) such as a links page, calendar page, library page and automated processes page (Kenyon, col. 4, lines 44-47).

Phillips Lindquist and Kenyon disclosed systems allowing authorized users access to specific group member area storage space (Phillips, col. 7, lines 9-13; Kenyon, col. 3, lines 7-13). Kenyon further provides users with a way of communicating between members to allow them to discuss and share group topics and interests (Kenyon, col. 4, lines 9-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the communication features of Kenyon into the shared group storage access of Phillips and Lindquist in order to enable users who share a common interest (such as photos, media) to not only be able to share data on a shared drive, but also to be able to communicate with each other to discuss such common interests.

52. Regarding claim 43, Phillips disclosed the limitations as described in claim 1. Phillips did not explicitly state wherein storing information about all members of a group comprises storing information about all members of a public group.

In an analogous art, Kenyon disclosed a system and method for automated website creation and access in which a system user may create a community website that provides community members with a forum to communicate between the members (Kenyon, col. 2, lines 41-46, 51-60). Kenyon further disclosed that the system user may configure the website to provide for unlimited access over the network (Kenyon, col. 2, line 63 through col. 3, line 5), the website providing an online forum for members of the community to exchange messages. In order for the host to provide such a forum, it would have to store in the least, each members identification and the message from each member.

Both Phillips and Kenyon disclosed systems allowing authorized users access to specific group member area storage space (Phillips, col. 7, lines 9-13; Kenyon, col. 3, lines 7-13). Kenyon further provides users with a way of communicating between members to allow them to discuss and share group topics and interests (Kenyon, col. 4, lines 9-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the communication features of Kenyon into the shared group storage access of Phillips in order to enable users who share a common interest (such as photos, media) to not only be able to share data on a shared

drive, but also to be able to communicate with each other to discuss such common interests.

53. Regarding claim 56, Phillips and Lindquist disclosed the limitations as described in claim 1. Phillips and Lindquist did not explicitly state wherein sharing the member-only static data resources associated with the group with the current members of the group and the new member comprises sharing a member-only private group website. In an analogous art, Kenyon disclosed a system and method for automated website creation and access in which a system user may create a community website that provides community members with a forum to communicate between the members (Kenyon, col. 2, lines 41-46, 51-60). Kenyon further disclosed that the system user may configure the website with security features in order to limit access to particular users (Kenyon, col. 2, line 63 through col. 3, line 5).

Phillips Lindquist Kenyon disclosed systems allowing authorized users access to specific group member area storage space (Phillips, col. 7, lines 9-13; Kenyon, col. 3, lines 7-13). Kenyon further provides users with a way of communicating between members to allow them to discuss and share group topics and interests (Kenyon, col. 4, lines 9-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the communication features of Kenyon into the shared group storage access of Phillips and Lindquist in order to enable users who share a common interest (such as photos, media) to not only be able to share data on a

shared drive, but also to be able to communicate with each other to discuss such common interests.

54. Claims 18-21, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips and Lindquist and further in view of Fanning et al. (U.S. 6,366,907).

55. Regarding claims 18-21, Phillips and Lindquist disclosed the limitations as described in claim 16. Phillips did not explicitly state wherein the data files comprise digital images, photographs, text files or multi-media files.

In fact, Phillips and Lindquist did not explicitly identify any types of files that users of the group can share. This would have motivated one of ordinary skill to search the prior art for common types of files that can be shared over a network.

Fanning disclosed a server that stores and provides data objects to clients (Fanning, col. 1, lines 40-47) in which the data objects may take the form of audio, text, images, and video (Fanning, col. 2, lines 34-36).

Therefore, the teachings of Fanning show that such types of data were well known types of data that is shared over the internet. Therefore, it would have been obvious to one of ordinary skill that the simple substitution of these well known commonly shared types for the shared data files of Phillips and Lindquist would result in the predictable result of sharing these types of files.

As such, it would have been obvious for one of ordinary skill in the art at the time the invention was made for users of Phillips to share the types of data described by Fanning to allow users with the desire to share such types of data to be able to do so.

56. Regarding claim 37, Phillips and Lindquist disclosed the limitations as described in claim 35. Phillips and Lindquist did not explicitly state wherein the computer readable medium is a client device.

However, it is commonly known in the art that client devices can be programmed with the functionality to act as a server. In other words, client devices and server devices are merely computers that are programmed with specific functionality to perform their jobs. Therefore it would have been obvious to one of ordinary skill in the art to configure any device a certain way if it is capable of being programmed to do so.

In an analogous art, Fanning disclosed a system in which client devices can simultaneously operate as a provider server to other client devices (Fanning, col. 2, lines 43-47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to improve a client device of Phillips the same way as those of Fanning by configuring the client device to act as a server, in order to make resources that the client stores available to other recipient clients on the Internet (Fanning, col. 2, lines 44-47), thereby improving the delegation of sharing of files to "nodes other than the remote file server node" (Phillips, see end of Abstract).

57. Claims 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips and Lindquist and further in view Harvey et al. (U.S. 6,487,583).

58. Regarding claims 51-53, Phillips and Lindquist disclosed the limitations as described in claim 1. Phillips also disclosed that at least one client node is provided with client manager software which enables the node to function as the client manager node (Phillips, col. 12, lines 23-25) and states that there may be more than one client manager node (col. 12, lines 28-30). Phillips also disclosed the client manager nodes have full control of access privileges and are able to create new user accounts (Phillips, col. 12, lines 30-40)

Phillips did not explicitly state promoting a current member to a group owner or founder, or demoting a group owner to a current member.

However, since Phillips disclosed that there may be more than one client manager node, it would have been obvious to one of ordinary skill in the art at the time the invention was made for client manager node to use its access privileges to modify a user's account to enable the user to become manager node, for the benefit of sharing access privileges with other members of the group.

In an analogous art, Harvey disclosed that a creator may designate specific users to perform certain functions within the community. A creator may delegate functions to other users (or administrators) and/or may empower other users to perform functions. Such functions include inviting members (i.e. becoming an assistant coach, See below for more detail), and punishing users (Harvey, col. 11, lines 50-60). Harvey

disclosed a system in which a creator can create a community group and invite members (Harvey, col. 4, lines 45-60) as well as designate certain users to allow others to access the community. Harvey provides an example, in which a coach of a softball team can choose members and designate them to be assistant coaches, thereby giving them the same privileges as the coach (Harvey, col. 12, lines 5-25). Therefore, it is clear that the creator is able to promote and demote users.

Both Phillips and Harvey disclosed systems that coordinate group functionality among members of a group. While the administrator of Phillips has the ability to create, invite, and remove users from the group, the administrator of Harvey is provided with extra control of the group as explained above. One of ordinary skill would have been motivated to combine the teachings of Phillips and Harvey to all the administrators of Phillips to also have that extra control over the group.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the extra control features of Harvey into Phillips to enable the administrator of the group to not have to take such drastic actions such as removing users for inappropriate conduct, but to rather just punish such users, for the benefit of better monitoring of functions within the group to ensure compliance with community standards (Harvey, col. 11, lines 55-62).

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey et al. (U.S. 6,487,583).

59. Regarding claim 57, Harvey disclosed the limitations as described in claim 1. Harvey disclosed that users may share pictures related to their community (Harvey, col. 4, lines 35-36).

Harvey did not explicitly state wherein the data resource being shared is a map.

However, Harvey disclosed an example of a community for the "Omaha Sailing Club" that describes a group of sailors in the greater Omaha, Nebraska area who have an interest in sailing and following sailing events.

Since the community members of Harvey are able to share pictures, it would have been obvious to one of ordinary skill in the art that such pictures could represent maps of the area, giving members more information about events such as the sailing events as described above.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made for the members of a community to share a picture identifying a geographic map in order to obtain location information, such as for the sailing events around, for example, the greater Omaha, Nebraska area, enabling the community members to meet up and attend these events, thereby bringing the members of the community closure, facilitating interaction and introduction between and among members (Harvey, see Abstract).

Response to Amendment

Applicant's arguments and amendments filed on 10/24/2007 have been carefully considered but they are not deemed fully persuasive.

Examiner agrees that Phillips did not explicitly state sharing a collection of contact information between members of the group, the collection of contact information including contact information for each member of the group. However, as shown in the above combination of Phillips and Lindquist disclosed this functionality, as explained in the above rejection.

Examiner agrees that Harvey's disclosed "Pal Function" does not read on Applicant's claimed collection of contact information that is accessible to members of a group and that includes contact information for each member of the group. As claimed, the "collection of contact information" must have contact information for every member of the group. Since Harvey's Pals list is personal to the user and only contains contact information for those "whom [the user] wishes to have available for communication at all times."

Examiner also agrees with Applicant's arguments regarding Harvey's disclosed "mailing list". While members of the group are able to send an email to the mailing list address, and that email gets distributed to the other members of the group, the members do not explicitly have access to the list of all the members' email addresses in this embodiment. While one may argue that having access to using the mailing list provides access to sending email to all the members, such access to the mailing list only provides access to a single address and not all of the member's contact information.

However Examiner respectfully disagrees with Applicant's argument that Harvey does not anticipate amended claim 1.

As shown in the above rejection, Harvey disclosed that a creator may require members to create a profile that includes the member's actual name and address. Harvey also disclosed this profile being accessed by other users of the community (Harvey, col. 12, lines 38-50).

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing

responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. B. D./
Examiner, Art Unit 2143

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Supervisory Patent Examiner, Art Unit 2154